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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,671	06/20/2001	Pamela M. Moss	50P4391	6367

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EXAMINER

CHANKONG, DOHM

ART UNIT PAPER NUMBER

2152

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,671

Applicant(s)

MOSS, PAMELA M.

Examiner

Dohm Chankong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2,10/2001 3,3/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

- 1> Claims 1-24 are presented for examination.

Claim Rejections - 35 USC § 112

- 2> The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 3> Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Examiner could not find description in the specification to enable one skilled in the art to implement the limitation of claim 6; that is, the method wherein certain files *must* exceed a certain size for a search of the library to occur. While the specification does raise the issue of transmitting large files, this is not synonymous to limiting the search to files of a predetermined size. For this reason, nothing described in the specification enables one of ordinary skill in the art to implement or make claim 6 within the claimed invention.

- 4> The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5> Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The claim language in the following claims is not clearly understood.

i. Claims 1, 10 and 15: "...uploading the specified media file to a predetermined server..." - it is not clear from where the media file is uploaded.

Claim Rejections - 35 USC § 103

6> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7> Claims 1, 3-5, 7-11 and 13-14 are rejected under 35 U.S.C 102(b) as being anticipated by Greenwood et al, U.S Patent No. 5,568,181 ["Greenwood"] in view of Crowle, U.S Patent No. 5,857,072 ["Crowle"].

8> As to claim 1, Greenwood discloses a method for distributing media files over a computer network [abstract], comprising:

receiving at a server an electronic message that includes one or more recipients along with a specified media file [Figure 2 <item 21>];

identifying the specified media file [Figure 2 <item 26> | column 4 <lines 17-26>];

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searching a library of frequently transmitted media files to determine whether the specified media file exists in the library [column 3 <lines 55-62> | column 4 <lines 17-35> where: the cache is equivalent in functionality to the claimed library]; and

if the specified media file exists in the library, transmitting a copy of the specified media file to said one or more recipients or, if the specified media file does not exist in the library, uploading the specified media file to a predetermined server and transmitting to said one or more recipients a copy of the specified media file from the predetermined server [column 4 <lines 36-55>].

Greenwood does not disclose that the electronic message is designated to be received by said one or more recipients.

9> Crowle teaches a data distribution system where an electronic message includes one or more recipients designated to receive the message along with a specified media file [column 4 <lines 29-34>]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Crowle's messaging system into Greenwood to allow Greenwood to communicate with a plurality of client computers. One would have been motivated to do utilize this implementation in order to distribute data to multiple network computer locations simultaneously [column 4 <lines 42-43>].

10> As to claim 3, Greenwood discloses the method of claim 1 wherein the specified media file comprises a video file [abstract].

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11> As to claim 4, Greenwood discloses the method of claim 1 wherein the specified media file comprises a multimedia file [abstract where: a video file is comparable to a multimedia file].

12> As to claim 5, Greenwood discloses the method of claim 1, further comprising detecting a size of the specified media file attached to the electronic message [column 6 <lines 43-48>].

13> As to claim 7, Greenwood discloses the method of claim 1, further comprising logging a number of times a particular file is attached to an electronic message for transmission over the computer network [column 3 <lines 59-62>].

14> As to claim 8, Greenwood discloses the method of claim 7, further comprising storing in said library a list of media files, each of which has been transmitted by electronic message over the computer network more than a predetermined number of times along with an associated location in the computer network for each file [column 3 <line 55> to column 4 <line 8> where: the cache is equivalent in functionality to the claimed library].

15> As to claim 9, Greenwood discloses the method of claim 7, further comprising ranking a plurality of media files based on how often each media file has been transmitted over the computer network [column 3 <line 62> to column 4 <line 3> where: files are removed from the cache based on a ranking system (i.e. "little-used" files are removed first)].

16> As to claim 10, Greenwood discloses the method of claim 9, further comprising storing in said library an identity of a predetermined number of said ranked media files, which have been transmitted most often over the computer network electronically, along with a location in the computer network of each of said ranked media files [column 3 <line 63> to column 4 <line 8>].

17> Claims 11 and 13-14 are claims to computer readable media that perform the steps of the method of claims 1 and 3-4 respectively. Therefore claims 11-14 are rejected for the same reasons as set forth in above paragraphs 8-11 for claims 1 and 3-4.

18> Claim 2 is rejected under 35 U.S.C 103(a) as being unpatentable over Greenwood and Crowle, in further view of Ramalay et al, U.S Publication Number 2002/0138619 A1 ["Ramalay"].

19> Greenwood does not specifically disclose the method of claim 1, wherein the specified media file comprises an audio file.

20> Ramalay teaches a media distribution system that interchangeably distributes both video and audio files [paragraph 44]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include audio file functionality into Greenwood's media distribution system to increase the capabilities of the system by allowing

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users to send and receive audio files in addition to the video files already distributed by Greenwood's scheme.

21> Claim 12 is a computer readable media that performs the steps of the method of claim 2. Therefore, claim 12 is rejected for the same reasons as set forth in above paragraphs 19 and 20 for claim 2.

22> Claim 6 is rejected under 35 U.S.C 103(a) as being unpatentable over Greenwood and Crowle.

23> Greenwood does not disclose a method wherein the search of the library is performed only if the specified media file exceeds a predetermined size. It is well known and expected in the art to include a minimum file size as a search parameter to refine and increase the efficiency of a file search. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the minimum file size as a parameter in Greenwood's cache and library search system when the system searches for the video files in the video library.

24> Claims 15- 18 are rejected under 35 U.S.C 103(a) as being unpatentable over Barnett et al, U.S Patent No. 6,356,948 ["Barnett"] in view of Greenwood.

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26> As to claim 15, Barnett discloses a system for transferring data from a sender to multiple recipients [abstract], comprising:

a server associated with a first computer [Figure 2 <items 52, 44(a-c), 42> where: the contributor module is considered a server and the contributors are computers];

an electronic messaging system adapted to operate over the server, said messaging system being adapted to generate electronic messages of a first type which have at least one media file attached thereto and which designate a plurality of recipients [column 4 <lines 1-25>], said messaging system being further adapted, when an electronic message of said first type is sent from said first computer [column 4 <lines 54-57>], to

identify the attached file [column 4 <line 59> where processing the data is considered identifying the file].

Barnett does not teach that the data are media files or searching a library of frequently transmitted files to determine whether the attached file exists in the library, and transmit, if the attached file exists in the library, a copy to said one or more recipients or, if the specified file does not exist in the library, upload the specified file to a predetermined server and transmit to said one or more recipients the specified file from the predetermined server.

27> Greenwood teaches transferring media files to recipients [abstract]. Barnett does disclose distributing data files, and it would have been obvious to one of ordinary skill in the art to implement Barnett's data files as media files to allow Barnett's system to distribute media files to multiple data destinations.

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Greenwood also discloses searching a library of frequently transmitted files to determine whether the attached file exists in the library, and transmit, if the attached file exists in the library, a copy to said one or more recipients or, if the specified file does not exist in the library, upload the specified file to a predetermined server and transmit to said one or more recipients the specified file from the predetermined server [column 3 <lines 55-62> | column 4 <lines 17-55>]. The use of such technology makes real-time video distribution over a network economically and technologically possible. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barnett's data distribution system to include Greenwood's library cache functionality for the purpose increasing Barnett's ability to manage and distribute media files.

28> As to claim 16, Barnett discloses a system wherein the file comprises a multimedia file [column 4 <lines 54-57>].

29> As to claim 17, Barnett discloses a system wherein the file comprises an audio file [column 4 <lines 54-57> where: voice mail is considered an audio file].

30> As to claim 18, Barnett does not disclose a system wherein the file comprises a video file.

31> Greenwood teaches a wherein the file comprises a video file [abstract]. It would have been obvious to one of ordinary skill in the art to implement Barnett's data files as media

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files to increase Barnett's capability of handling more data types from a system or application [column 4 <lines 54-57>] and allow Barnett's system to distribute media files to multiple data destinations.

32> As to claim 19, Barnett discloses the system of claim 15, wherein the file is copied to a first recipient by copying the file from the first server to a second server associated with the first recipient [Figure 2 <items 44(a-c), 42, 52, 58> | column 4 <lines 38-45 and 58-61> where: contributor module is considered the first server].

33> As to claim 20, Barnett discloses the system of claim 15, wherein the message is generated on a system, and wherein the file is uploaded to the server from the system when the message is sent [column 4 <lines 34-37, 45-47 and 54-57> where: the contributors (system) send their data to their contributor module (server) and data (such as email and voice mail) is uploaded to the contributor module].

34> Claims 21-24 are rejected under 35 U.S.C 103(a) as being unpatentable over Fardella et al, U.S Patent Publication Number 2001/0032246 A1 ["Fardella"] in view of Crowle.

35> As to claim 21, Fardella discloses a method for distributing media files over a server [abstract], comprising:

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providing an electronic message designating a recipient, said electronic message having a media file attached thereto, said media file being resident on said server [abstract | paragraph 19];

sending the electronic message sans media file to each recipient along with an identifier that uniquely identifies the media file [paragraphs 15 and 16]; and

forwarding, for each recipient when the message is opened by said each recipient, the file from said server to the recipient [paragraph 17].

Fardella does not disclose that the message is designated to a plurality of recipients.

36> Crowle discloses a method for distributing files and providing electronic messages designated to a plurality of recipients [abstract]. The use of this technology allows a single message and single copy of data needs to be sent across networks to a plurality of different locations. Therefore it would have been obvious to one of ordinary skill in the art to include Crowle's distribution methods in Fardella to allow for efficient data distribution to multiple locations.

37> As to claim 22, Fardella discloses the method of claim 21 further comprising removing the media file from the electronic message to be sent to the plurality of recipients before any uploading of the media file to the server can occur and prior to sending the electronic message sans media file to the plurality of recipients [paragraph 7 where: the message is sent from the first individual (without video attached) to the server and whereby the video is only

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uploaded after receiving notice from the server, separate from the initial message to be sent to the recipients].

38> As to claim 23, Fardella discloses the method of claim 21 further comprising inserting an identifier in the electronic message that uniquely identifies the media file and a location of the media file on a computer network [paragraphs 16 and 17].

39> As to claim 24, Fardella discloses the method of claim 21, wherein the identifier comprises a hyperlink to a uniform resource locator (URL) on a computer network [paragraph 17].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S Publication No. 2001/0052019 A1 to Walters et al for a video email system to a plurality of recipients;

U.S Patent No. 5832217 to Atalla for the distribution of video files to a plurality of recipients with the use of community servers;

U.S Patent No. 5896506 to Ali et al for the use of cache servers in a digital library system;

U.S Patent No. 6651451 to Adragi for the use caching popular files and a method for their distribution using email;

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U.S Patent No. 6732183 to Graham for a system of streaming video and audio data to multiple clients using forwarding methodology.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is (703)305-8864. The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC
8.18.2004


ZARNI MAUNG
PRIMARY EXAMINER